

Remarks/Arguments:

Claims 15-21, previously presented, and claims 22 and 23, presented hereby, are pending.

According to the Office Action, the Amendment filed May 10, 2004, is non-responsive because claims 15-21 are allegedly "drawn to a non-elected invention." The Office Action is mistaken.

The Office Action justifies the non-responsive allegation "because the originally presented claims 8-14 were drawn to a method of making a medicament as clearly identified on page 2 of the Office Action of 31 December 2003." However, this is merely a statement by the PTO as to what the claims define, which the PTO cannot do. It is applicants' sole prerogative to define the claims. *In re Pilkington*, 162 USPQ 145, 148 (CCPA 1969).

Contrary to the allegation set forth in the Office Action, claims 8-14 are not limited to a method of making a medicament. The plain language of the claims, in fact, shows that the allegation is incorrect.

Generic claim 8 clearly recites (*emphasis added*) "for the *treatment* of a pathogenically altered bacterial flora in the gastrointestinal tract, respiratory and urogenital systems, [and] the skin."

Claim 9 limits claim 8 to such use with a specific dosage amount and mode of administration. Claim 10 limits claim 8 to such use "for the treatment of alterations of the intestinal flora." Claim 11 limits claim 8 to use "for the treatment of alterations of microbially induced skin diseases." Claim 12 limits claim 8 to use "for the treatment of aberrations of the human vaginal flora."

Moreover, the aforesaid limitations in claims 10, 11, and 12 would have no meaning if, as alleged in the Office Action, claim 8 were limited to a method of *making* a product. As the PTO frequently argues, reciting how a product is to be ultimately used has no limiting effect on a claim drawn to the method of making the product; e.g., as set forth in the first Office Action on the merits (mailed January 8, 2004), page 6, "how one uses the composition does not materially change the actual physical steps of making the composition." Furthermore, the Office Action, in effect, improperly creates a retroactive restriction requirement. The Office Action belatedly alleges "the claims lack unity of invention because the alleged special technical feature, natriubiotics, are not a contribution over the art as shown by Forssmann et al." Contrary to the Office Action, this is not the case where the originally presented claims do not contain the subject matter found in the latter presented claims. As shown above, the method-of-treatment subject matter is found in the originally presented claims. Creation of such a retroactively effective restriction is improper, because applicants have been denied the opportunity to elect the method-of-treatment subject matter found in the originally presented claims, which claims are alleged to lack unity of invention, only after applicants replied to the first Office Action.

Still further, the PTO incorrectly maintains: "The only step that can be surmised [in claim 8] is the combination of the natriubiotics and a carrier suitable for either pharmaceuticals (claims 8-12) or food (claims 8 and 13-14) to make the preparation, whereas the instant claims [15-21] are drawn to several methods of use of the medicament." The aforesaid statement is wrong for two reasons: first, it reads non-existing language into the claims, i.e., the claims recite neither the

"combination step nor the "carrier suitable for either pharmaceuticals . . . or food." On the other hand, the originally presented claims do recite a "treatment" step as well as "systems" of the body to be *treated*.

For the foregoing reasons, presented claims 15-19 do, in fact, read on the subject matter found in the originally presented claims 8-14, i.e., in the absence of a restriction requirement under 35 USC 121, claims 15-21 read on the implicitly elected invention in the claims originally presented for examination. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." MPEP 2111 "During examination, the claims must be interpreted as broadly as their terms reasonably allow. " MPEP 2111.01.

Concerning presented claims 20 and 21, the Office Action fails to consider that claims 20 and 21, in fact, fall within the "surmised" step of food preparation. Claim 20 provides a method of preserving food "by adding a natriubiotic to the food." Claim 21 provides a method for controlling bacterial growth in fermenting food "by adding a natriubiotic to the food during fermentation."

Notwithstanding the foregoing, and without waiving their rights of objection to the finding of non-responsiveness set forth in the Office Action, applicants present, hereby, new claims 22 and 23. Claims 22 and 23 are drawn to a method of making it an antibacterial agent, which comprises combining a natriubiotic with a pharmaceutically acceptable carrier.

Favorable action is requested.

Respectfully submitted,

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